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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,886	10/03/2000	Toshiya Imai	198009US2S	6145

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EXAMINER

EASTHOM, KARL D

ART UNIT	PAPER NUMBER
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2832

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/677,886

Applicant(s)
Imai et al.

Examiner
Karl Easthom

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2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 12, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-20 is/are pending in the application.
- 4a) Of the above, claim(s) 3, 9, 10, and 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 & 8 6) ☐ Other:

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1. Applicant's election with traverse of Species 17, in Table 1, sample 17, readable on claims 3-8 and 11 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the reasons for independence and distinctness are not clearly stated, that the species are not mutually exclusive, and that there is no serious burden. This is not found persuasive because different species are usually independent, and unrelated unless related under the categories of MPEP 806.05. MPEP 8.06.04b. As noted in the earlier office action, since applicant appears to be arguing that the species are not distinct, applicant "should submit evidence ...showing the species to be obvious variants or clearly admit on the record that this is the case". The mode for indicating species is spelled out in MPEP 814, and 809.02, and this was followed by the Examiner, so that indicating other items under MPEP 816 is not required, since that section applies only to related inventions. Nonetheless, the different species are mutually exclusive since a glass coating is distinct from a polymer coating for example, use of one excludes the other. As to the lack of burden asserted, each extra species creates myriad issues, more than linearly multiplying the time requirement, and each requires independent analysis (unless of course applicant makes the admissions noted above). This is added to other burdens such as responding to traversals, requesting more information regarding untranslated items in an IDS, etc., etc., such that less and less time can be devoted to delivery of a quality product, creating more and more burden.

The requirement is still deemed proper and is therefore made FINAL.

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2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 4 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nied et al.

Nied discloses the claimed invention at Fig. 5 with electrodes 0mm from phenol or epoxy resin coating 160 (polyetherimide) (or thermal plastic or polymer), col. 3, lines 1-15. In claim 7, arc spraying is noted at the same passage. In claim 4, the test is met since a ball of a small size can be dropped from 40 mm on the sides or when attached to the sides, where "the falling ball test" does not specify more. Or, since the claimed materials are the same as disclosed, the same properties are inherent.

4. Claims 3-5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Julke et al.

Julke discloses the claimed invention at Fig. 1 with electrodes 0mm from epoxy or silicone resin coating 4. In claim 4, the test is met since a ball of a small size can be dropped from 40 mm on the sides or when attached to the sides, where "the falling ball test" does not specify more. Or, since the claimed materials are the same as disclosed, the same properties are inherent. In claim 3, the thickness of 2mm is disclosed at col. 4, lines 18-20.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nied et al. in view of Seike et al. The claimed invention is disclosed as noted except the electrode thickness. Seike discloses at col. 3, lines 39-47 and Table 1 electrodes 2,3 at the claimed thickness to enhance surge tolerance, and it would have been obvious to form such electrodes for that reason.

7. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nied et al. in view of Matsuoka. The claimed invention is disclosed as noted except the electrode material and the high resistance layer thickness. Matsuoka discloses the thickness for the side layer as 10um in order to protect against moisture, col. 2, lines 15-20 at col. 4, lines 60-65, and material at col. 5, lines 1-25, as well known for attachment to leads by solder. It would have been obvious to employ the well known material in order to render the electrode solderable, and to employ the thickness in order to protect against moisture.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nied et al., Sokoly, or Ellis et al. '101 in view of JP50027986 (abstract). The claimed invention is disclosed as noted above for Nied, or at Fig. 1 for Ellis et al., except for the material of the glass collar. Similarly, Ellis discloses the invention except the material of the glass collar 13 with electrode 12 side to side distance of zero. Likewise for Sokoly et al., disclosing glass collar 22 for zinc varistor 12. JP '986 discloses using a glass containing bismuth as a main ingredient for the purpose of obtaining a good nonlinearity coefficient, long lifetime and small variance in performance for zinc

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oxide varistors suggesting good use with the zinc oxide varistors of Nied, Sokoly, Ellis which are similarly collared, rendering the modification obvious, where the latter two suggest any type of glass collar is a good insulator.

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Easthom whose telephone number is (703) 308-3306.


KARL D. EASTHOM
PRIMARY EXAMINER